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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/744,125      | 09/17/2001  | Christophe Marcireau | A3233A US           | 2418             |

5487 7590 12/03/2002

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| EXAMINER |
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MONSHIPOURI, MARYAM

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1652

DATE MAILED: 12/03/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/744,125**

Applicant(s)  
**Marcireau et al.**

Examiner  
**Maryam Monshipouri**

Art Unit  
**1652**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) 28-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-27 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 1652

Applicant's response to lack of unity requirement filed 8/5/2002 (Paper # 11) is acknowledged.

Applicant elected Group I invention directed to claims 1-27 with traverse.

In traversal of restriction requirement applicant argues (1) that under 35 U.S.C. section 121 "two or more independent and distinct inventions ... in one application may ... be restricted to one of the inventions." Inventions are "independent " if " there is no disclosed relationship between two or more subjects disclosed". The term "distinct" means that "two or more subjects are related ... but are capable of separate manufacture, use or sale as claimed. AND are PATENTABLE OVER EACH OTHER" (MPEP 802.01). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions".

According to applicant, The examiner has failed to define compositions and methods for using such compositions with properties so distinct to warrant separate examination and search. In particular, the Examiner has failed to note separate classification for each Group of claims. Consequently, no evidence apart from Examiner's opinion has been provided that each of these Groups of claims fall into a separate classification.

Art Unit: 1652

(2) Moreover, the claims of Group II, which are drawn to antibodies, utilize MIF 1 protein of the claims of Group I; the claims of Group III which is drawn to a hybridization assay, use DNA molecules of the claims of Group I etc. Consequently, all Groups must be rejoined.

(3) In addition, in view of applicant PCT Rule 13.1 states that 'International application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept and since the Examiner has admitted that the claims of Groups I and III share a special technical feature Groups I and III inventions should be rejoined.

Finally , applicant's in light of the above arguments request rejoinder of all inventions or at least those of Groups I and III as conjoint examination of all inventions does not impose an undue burden of searching on the Examiner.

These arguments were fully considered but were found **unpersuasive**. The examiner finds applicant's **first** arguments more relevant to a regular U.S. Utility application rather than a 371. Applicant is well aware that in order to demonstrate lack of unity one does not need to provide separate classes/subclasses for separate inventions and hence, undue burden of searching. All is required is to demonstrate that the inventions lack a common technical feature as already done clearly, in the previous office action.

However, in order to be responsive to applicant's interest is classes/subclasses wherein the claimed inventions belong the following information is provided:

Group I, claims 1-27, classified in class 435/194; 435/320.1, 252.3, 325, 530/350

Group II, claims 28-30 and 32, classified in class 530/387.1

Art Unit: 1652

Group III, claim 31, classified in class 435/6.

Group IV, claims 33-38, classified in class 435/15.

Group V, claims 39-44, classified in class 514/789 and 435/15.

Thus, applicant can appreciate that in the case of most inventions there is hardly any overlap between the distinct classes/subclasses of each invention and in cases where there is overlap searches required for each invention are not coextensive. Therefore, clearly, rejoining all above indicated inventions **does impose an undue burden of searching on the examiner.**

With respect to applicant's **second** argument directed to relationship among all listed inventions, the examiner maintains that said comments are not relevant to criteria under which lack of unity is held. For example, even though antibodies and proteins may be related according to applicant's arguments said products **lack a common special technical feature** because they are directed to two patentably distinct products of unrelated chemical structure and function.

With respect to applicant's **third** argument, applicant is reminded that sharing a common special technical feature in some cases (such as Groups I and III, here) does not justify rejoinder under PCT Rule 13.1. Applicant is advised to review categories listed under **37 CFR 1.475(b)** in order to obtain more information as to why Groups I and II are being held to lack unity.

In conclusion, in view of all above explanations together with reasons provided previously, lack of unity is maintained according to previous office action and is hereby made **Final.**

Art Unit: 1652

Upon further review of the previous office action further restriction deemed necessary as indicated below:

**Group I (a)**, claims 1-27 drawn to sequences encoding SEQ ID NO:2.

**Group I(b)**, claims 1-27 drawn to sequences encoding SEQ ID NO:8.

The inventions listed as Groups I(a)-(b) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: each inventions is directed to a product of unrelated chemical structure and function.

A telephone call was made to Mr. W. C. Coppola on 11/19/2002 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maryam Monshipouri, Ph.D. whose telephone number is (703) 308-

1083.

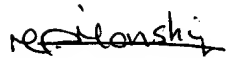
Art Unit: 1652

The Examiner can normally be reached daily from 8:30 A.M. to 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr.

P. Achutamurthy, can be reached at (703) 308-3804. The OFFICIAL fax number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.



Maryam Monshipouri, Ph.D.

Primary Examiner